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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/662,553	09/15/2003	Edward Houston	59890 (50024)	2280

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EXAMINER

MCCORMICK EWOLDT, SUSAN BETH

ART UNIT	PAPER NUMBER
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1654

DATE MAILED: 03/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/662,553

Applicant(s)

HOUSTON, EDWARD

Examiner

Susan B. McCormick-Ewoldt

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 33-51 and 66 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 33-51 and 66 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. ____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Election/Restriction

Applicant's election without traverse of Group I in the reply filed on October 8, 2004 is acknowledged.

Claims Pending

Applicant has cancelled claims 1-32, 52-65 and has added new claim 66. Claims 33-51 and 66 will be examined on the merits.

Priority

Acknowledgment is made of Applicant's claim for priority under 35 U.S.C. 119(a)-(d) based upon an application filed in the United Kingdom (GB0217372.2) on July 25, 2002. A claim for priority under 35 U.S.C. 119(a)-(d) cannot be based on said application, since the United States application was filed more than twelve months thereafter.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 45, 48, 66 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Claim 45 recites the limitation "the formulation" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 48 recites the limitation "the formulation" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 66 recites the limitation "the formulation in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 33-51 and 66 are rejected under 35 U.S.C. 103(a) as being unpatentable over McShane (US 3,928,579), Sasaki *et al.* (US 4,628,001), Seidel (US 5,972, 920) and Veenhuis *et al.* ("Highly increased urinary 1-hydroxypyrene excretion rate in patients with atopic dermatitis treated with topical coal tar").

A method of preparing a composition for the treatment of dermatological disorders by filtering coal tar to remove impurities by filter compression and the composition contains the filtered coal tar is claimed.

McShane (US 3,928,579) teaches the purification of coal tar that has desirable therapeutic properties useful in the treatment of chronic skin diseases such as psoriasis (column 1, lines 5-7, 20-21). Additionally, McShane teaches that coal tar can be purified readily by filtration of insoluble residues and boiling the residue (column 1, lines 38, 45-55 and claim 1). McShane does not teach the coal tar being filtered with a compressed charcoal filter nor adding the surfactants. However, once the impurities are removed, other acceptable dermatological acceptable vehicles can be incorporated in the coal tar extract.

Sasaki *et al.* (US 4,628,001) teaches filtering coal tar by using a compression filter (see Example 18).

Seidel (US 5,972, 920) teaches the following components to be used in a formulation suitable for the treatment of skin conditions such as psoriasis (column 2, lines 55-56). The active components are coal tar, isopropyl myristate, ethyl alcohol and zinc pyrithione (column 3, lines 25, 35-38, 58-59) and sodium lauryl sulfate (column 4, lines 17-18). Seidel also teaches that the formulation can be exhibited in spray form (column 6, lines 7-9)(see also claims).

It has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 220 F2d 454,456,105 USPQ 233; 235 (CCPA 1955). See MPEP § 2144.05 part II. Variations of

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components in dermatological compositions were well known in the art. It would have been obvious to one of ordinary skill in the art at the time Applicants' invention was made to determine all operable and optimal concentrations of components because concentration is an art-recognized result-effective variable which would have been routinely determined and optimized in the dermatological art. Further, one of ordinary skill in the art would have been motivated to have modified the proportions of active ingredients in the composition in order to enable the content of the preparation to be matched with the demands and needs of individuals which needed treatment. Such variations in amounts of dermatological active ingredients are considered merely optimization of result effective variables, conventional practice in the art of pharmacology.

These references show that it was well known in the art at the time of the invention to use the claimed ingredients in compositions that treat dermatological disorders. It is well known that it is *prima facie* obvious to combine two or more ingredients each of which is taught by the prior art to be useful for the same purpose in order to form a third composition which is useful for the same purpose. The idea for combining them flows logically from their having been used individually in the prior art. *In re Pinten*, 459 F.2d 1053, 173 USPQ 801 (CCPA 1972); *In re Susi*, 58 CCPA 1074, 1079-80; 440 F.2d 442, 445; 169 USPQ 423, 426 (1971); *In re Crockett*, 47 CCPA 1018, 1020-21; 279 F.2d 274, 276-277; 126 USPQ 186, 188 (1960).

Based on the disclosure by these references that these substances are used in compositions to treat dermatological disorders, an artisan of ordinary skill would have a reasonable expectation that a combination of the substances would also be useful in creating compositions to treat dermatological disorders. Therefore, the artisan would have been motivated to combine the claimed ingredients into a single composition. No patentable invention resides in combining old ingredients of known properties where the results obtained thereby are no more than the additive effect of the ingredients. See *In re Sussman*, 1943 C.D. 518; *In re Huellmantel* 139 USPQ 496; *In re Crockett* 126 USPQ 186.

The combined references teach filtering coal tar to remove impurities and adding the surfactants for a composition in treating dermatological disorders. As discussed above, filtering coal tar is important to remove the impurities for use in dermatological treatments as taught by McShane. Veenhuis teaches that coal tar preparations can cause carcinogens in animals thus

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shows that filtering is important in obtaining coal tar for use in dermatological disorders. In addition, Seidel teaches the surfactants and carriers that are used in formulations for treating psoriasis and other skin disorders. Thus, a person of ordinary skill in the art would reasonably expect that filtering coal tar and adding surfactants and carriers to the coal tar as taught by the references could be successful in treating dermatological disorders. Based on this reasonable expectation for success, a person of ordinary skill in the art would be motivated to modify the teachings of the references for removing impurities in coal tar for use in dermatological disorders.

From the teaching of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention.

Therefore, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the cited references, especially in the absence of evidence to the contrary.

Summary

No claim is allowed.

Future Correspondence

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Susan B. McCormick-Ewoldt whose telephone number is (571) 272-0981. The Examiner can normally be reached Monday through Thursday from 6:00 a.m. to 4:30 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campell, can be reached on (571) 272-0974. The official fax number for the group is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Susan D. Lee
3-17-05
SUSAN COE
PRIMARY EXAMINER